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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/042,951 03/17/98 CHANG

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EXAMINER

LM02/1007

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ART UNIT

PAPER NUMBER

2744

DATE MAILED:

10/07/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**09/042,951**

Applicant(s)  
**KIM CHANG et al.**

Examiner  
**Sonny Trinh**

Group Art Unit  
**2744**



☒ Responsive to communication(s) filed on Mar 17, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-20 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-20 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

2. **Claims 1-5, 8** are rejected under 35 U.S.C. 102(e) as being anticipated by Coursey (U.S. Patent number 5,950,130).

3. As to **claim 1**, Coursey discloses the mobile station with intelligent roaming and over the air programming features including a customer service center (CSC, Fig. 8, column 23, lines 4-17), a mobile switching center (MSC) (column 11, lines 55-64; column 22, lines 58-67; column 23, lines 1-3), a base station controller (column 22, lines 13-33). Coursey further discloses the transceivers send the request for interrogating the mobile telephone's protocol capabilities (column 31, lines 31-43)

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and the mobile responses include the BAND, MODE and CAP field describing the band and mode capability of said mobile telephone (column 15, lines 29-46).

4. As to **claim 2**, Coursey further discloses the analog band, digital cellular band, and the digital personal communication service (column 4, lines 21-39) and the PCS system mention throughout the reference. It should be noted that the different frequency bands are defined by the FCC and it is obvious to comply with the FCC for compatibilities reasons.

5. As to **claim 3**, Coursey further discloses the preferred roaming list (abstract, column 3, lines 57-67; column 4, lines 1-4).

6. As to **claim 4**, Coursey further discloses the different service options that are available to the mobile telephone (column 15, lines 29-46; column 4, lines 1-4).

7. As to **claim 5**, Coursey further discloses the different service options that are supported by the mobile telephone (column 14, lines 59-67; column 15, lines 1-13).

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8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claim 6** is rejected under 35 U.S.C. 103(a) as being unpatentable over Coursey (U.S. Patent number 5,950,130) in view of Vanttila et al. (U.S. Patent number 5,819,178).

10. As to **claim 6**, Coursey discloses the invention except for the SERVICE OPTION field is utilized to initiate an appropriate provisioning of the mobile telephone. In an analogous art, Vanttila discloses the mobile terminal having network services activation through the use of point to point short message service. Vanttila further discloses the sending of the message to the service center for provisioning of the mobile telephone (column 2, lines 58-67, column 3, lines 1-21). At the time of the invention, it would have been obvious for a person skilled in the art to combine Coursey and Vanttila to obtain the invention as claimed in claim 6; the motivation / suggestion for doing so would be to have the network activates the services requested by the mobile terminal without operator's intervention.

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11. **Claim 7** is rejected under 35 U.S.C. 103(a) as being unpatentable over Coursey (U.S. Patent number 5,950,130) in view of Cropper (U.S. Patent number 5,819,178).

12. As to **claim 7**, Coursey discloses the invention except for the SERVICE OPTION field is utilized to initiate an appropriate provisioning of the Home Location Register (HLR). In an analogous art, Cropper discloses the methods and apparatus for accessing subscriber information in interconnected wireless telecommunications networks, Cropper further discloses that the HLR database includes subscriber data for mobile terminals provisioned on the first wireless network (Fig. 2, column 4, lines 19-34, claims 13-14). At the time of the invention, it would have been obvious for a person skilled in the art to combine Coursey and Cropper to obtain the invention as claimed in claim 7; the motivation / suggestion for doing so would be to let the network know what kind of services the mobile station is capable of handling in order to better service it.

13. As to **claim 8**, Coursey further discloses the mobile telephone communication network may be a code division multiple access (CDMA) network (column 4, lines 21-38, column 11, lines 55-64).

14. As to **claims 9-16**, these claims merely reflect the apparatus to the method claim of claim 1-8 (respectively) and are therefore rejected for the same reasons.

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15. As to **claims 17-20**, Coursey also set forth the mobile telephone aspect of claims 9-12 (Figs. bc) respectively and are therefore rejected for the same reasons.

### ***Citation of Pertinent Prior Art***

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

<b>Inventor</b>	<b>Publication</b>	<b>Number</b>	<b>Disclosure</b>
Gerszberg	US Patent	5,297,192	Method and apparatus for remotely programming a mobile data telephone set
Heidari	US Patent	5,854,978	Remotely programmable mobile terminal
Amadon et al.	US Patent	5,301,223	Cellular telephone system with remote programming, voice responsive registration and real time billing

### ***Conclusion***

***Any response to this action should be mailed to:***

*Commissioner of Patents and Trademarks*

*Washington, D.C. 20231*

***or faxed to:***

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*(703) 308-9051, (for formal communications intended for entry)*

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*"PROPOSED" or "DRAFT")*

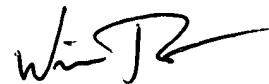
*Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington.*

*VA., Sixth Floor (Receptionist).*

*Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sonny Trinh whose telephone number is (703) 305-1961. The examiner can normally be reached Monday through Friday from 8:00 am to 4:30 pm, except on the first Friday of the bi-week.*

*Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700.*

*Sonny Trinh*     *S. T.*



**William G. Trost**  
**Primary Examiner**

October 4, 1999